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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/446,691	12/27/1999	LINO DAINESE	695-110P	2754

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EXAMINER

LEWIS, KIM M

ART UNIT	PAPER NUMBER
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3761

DATE MAILED: 08/13/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/446,691

Applicant(s)

DAINESE, LINO

Examiner

Kim M. Lewis

Art Unit

3761

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 12 March 2001 and 23 April 2001.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 and 4-8 is/are rejected.
- 7) ☒ Claim(s) 2, 3 and 9 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☒ Other: *Detailed Action*

## **DETAILED ACTION**

### ***Response to Amendment***

1. The amendments filed on 3/12/01 and 4/23/01 have been received and made of record in the application file wrapper. As requested claims 1-7 have been amended and claims 8-9 have been added.

### ***Allowable Subject Matter***

2. The indicated allowability of claims 1 and 4-7 is withdrawn in view of the newly discovered reference(s) to U.S. Patent Nos. 5,620,412 and 4,481,941. Rejections based on the newly cited reference(s) follow.

3. Claims 2, 3 and 9 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

### ***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1 and 6-8 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 5,620,412 ("Modglin").

Art Unit: 3761

As regards claim 1, Modglin discloses all claimed limitations of the invention. More specifically, Modglin discloses a hip abduction system, which is *capable* of protecting a portion of the back of a motorcyclist. As can be seen from the marked-up Fig. 1, the system comprises an upper support, a lower support, said upper support being aligned with said lower support, said upper support and lower support being provided with means for fixing them to a motorcyclist's body, each of said supports carrying a plurality of substantially rigid elements fixed thereto. Modglin also discloses that the upper and lower supports are hinged to one another (col. 3, lines 46-49 and col. 4, 19-52).

As regards claim 6, note braces (5) and (8).

As regards claim 7, member (32) is considered a belt.

As regards claim 8, caliper (20) comprises upper and lower portions, which are connected by a pivot joint. It is inherent that the pivot joint is a pin of some sort (e.g., a screw).

6. Claims 1, 4 and 5 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 4,481,941 ("Rolfes").

As regards claims 1, 4 and 5, Rolfes anticipates the invention as claimed. More specifically, Rolfe discloses a hip system capable of protecting a portion of a user's back. The system comprises upper and lower supports having an intermediate layer of padding material (52,124) attached thereto for protecting the user's body part. The upper support is vertically aligned with the lower support (Fig. 8) and each being

Art Unit: 3761

provided with a means for fixing to the user (54, 116). Additionally, each of the upper and lower supports comprises a plurality of rigid elements (86, 88, 112, 114) and the upper support is hinged to the lower support via hinge pin (40).

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

9. Claims 4 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Modglin in view of U. S. Patent No. 4,481,941 ("Rolfes").

As regards claims 4 and 5, Modglin fails to teach an intermediate layer.

However, Rolfes discloses a hip system comprising upper and lower supports wherein the upper and lower supports each comprise an intermediate layer of padding material, which is capable of impact absorption and which protects the user's body from the rigid portions of the system.


Art Unit: 3761

In view of Rolfes, it would have been obvious to one having ordinary skill in the art to modify Modglin with the addition of an intermediate layer of padding material to protect the user body from the rigid abduction system.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kim M. Lewis whose telephone number is 703.308.1191. The examiner can normally be reached on Mondays and Tuesdays from 6:30 am to 3:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Weilun Lo can be reached on 703.308.1957. The fax phone numbers for the organization where this application or proceeding is assigned are 703.305.3590 for regular communications and 703.305.3590 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703.308.0858.



**Kim M. Lewis**  
**Primary Examiner**  
**Art Unit 3761**

kml  
August 9, 2003